UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,961	08/04/2003	Takeshi Iijima	58647-156	4476

20277 7590 04/01/2008

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
EISEMAN, ADAM JARED	
ART UNIT	PAPER NUMBER
3736	
MAIL DATE	DELIVERY MODE
04/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/632,961	IIJIMA ET AL.	
	Examiner	Art Unit	
	ADAM J. EISEMAN	4153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. 09/894,512.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/27/2004, 8/4/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the preliminary amendment filed on August 3, 2003. Claims 1-5 have been cancelled. Claims 6-15 are pending in this application. The Information Disclosures Statements filed on August 4, 2003 and April 27, 2004 are acknowledged.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-16 recites the limitation "body fat meter" in the preamble of the claims. There is insufficient antecedent basis for this limitation in the claims; as claim 7, which claims 10-16 are dependant on, does not state a body fat meter, but a bioelectric impedance measuring apparatus.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 7, 8, 9, 11, and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,618,616 in view of Iwabuchi (U.S. Patent 6,360,124).

Claim 7 of the conflicting patent claims a bioelectrical impedance measuring device with a personal data input, a plurality of electrodes for bioelectric impedance measurement, at least one memory area for storing the personal data, a control device for storing and retrieving personal data of a touched electrode from the memory area, and a weight scale with a display. However, it does not claim that the electrodes have identification, or the display unit as capable of displaying a sign representing the touched electrode.

Iwabuchi teaches identifying the electrodes of a bioelectric impedance measuring apparatus. (figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to identify the electrodes on the bioelectric impedance measuring device as taught by Iwabuchi. Further it would have been obvious to one of ordinary skill in the art at the time of the invention that the electrodes would be disposed on the upper surface of the scale body. All other limitations of claims 7, 11, and 14 of the instant application are taught in claim 7 of the conflicting patent which is dependant on claim 1.

3. Claims 6 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,618,616 in view of Laurent (U.S. Patent 5,469,857).

Claim 7 is described above.

Laurent teaches a display that shows which electrodes are in contact with the heart (abstract).

It would have been obvious to one of ordinary skill in the art or medical diagnostics at the time of the invention to display a sign to represent an electrode is in contact with a desired target (or touched).

4. Claim 10 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,618,616 in view of Laurent and Iwabuchi.

Laurent teaches a display that shows which electrodes are in contact with the heart (abstract).

Iwabuchi teaches identifying the electrodes of a bioelectric impedance measuring apparatus. (figure 2).

It would have been obvious to one of ordinary skill in the art or medical diagnostics at the time of the invention to display a sign to represent an electrode is in contact with a desired target (or touched). Further It would have been obvious to one of ordinary skill in the art at the time of the invention to identify the electrodes on the bioelectric impedance measuring device as taught by Iwabuchi.

5. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,618,616 in view of Drinann (U.S. Patent 6,354,996) and Iwabuchi.

Claim 7 of the conflicting application is described above. However it does not claim scroll up, scroll down, and enter buttons on the device upper surface or each electrode having identification.

Drinan discloses a scroll up, scroll down, and enter button on the face of a body composition analyzing weight scale device (figure 2).

Iwabuchi teaches identifying the electrodes of a bioelectric impedance measuring apparatus. (figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to put a scroll up, scroll down, and enter button on the face of the bioelectric impedance measuring device of claim 7. Further it would have been obvious to identify the electrodes as taught by Iwabuchi.

6. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,618,616 in view of Drinan and Iwabuchi.

Claim 6 of the conflicting application claims a bioelectrical impedance measuring device with a personal data input, a plurality of electrodes for bioelectric impedance measurement, at least one memory area for storing the personal data, a control device for storing and retrieving personal data to and from the memory area when an electrode is touched, and a power switch device responsive to the touch of any of the electrodes

for turning power on. However it does not disclose a scale for measuring body weight with a plurality of electrodes on the upper surface or the electrodes having identification.

Drinan is described above as a body composition analyzer that includes a scale with electrodes on the upper surface.

Iwabuchi teaches identifying the electrodes of a bioelectric impedance measuring apparatus. (figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bioelectric impedance measuring apparatus of claim 6 with a scale having electrodes disposed on the upper surface. Further, it would have been obvious to identify the electrodes as taught by Iwabuchi.

7. Claims 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,618,616 in view of Drinan and Iwabuchi.

Claim 9 of the conflicting application claims a bioelectric impedance measuring device with a personal data input, a plurality of electrodes for bioelectric impedance measurement, at least one memory area for storing the personal data, a control device for storing and retrieving personal data to and from the memory area when an electrode is touched, a bioelectrical impedance circuit for measuring bioelectric impedance, a touch sensitive switch circuit for initiating current flow through electrodes, a mode switching device which switches the connection of said electrodes from said bioelectrical impedance measuring circuit to the touch sensitive switch circuit or inversely, and an internal timer for measuring period of non interruption of data entry in

the control device to shut the power of the device off after exceeding a predetermined length of time. However, claim 9 does not claim a weight scale for measuring body weight or the electrodes having identification.

Drinan is described above as a body composition analyzer that includes a scale with electrodes disposed on the upper surface.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bioelectric impedance measuring apparatus in claim 9 with Drinann's scale for measuring body weight with electrodes on the upper surface. Further, it would have been obvious to identify the electrodes as taught by Iwabuchi.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 6, 8-10, and 12-16 ? rejected under 35 U.S.C. 103(a) as being unpatentable over Drinan et al. (US Patent 6,354,996) in view of Trautman (US Patent 5,121,470).

Drinan discloses a body composition analyzer that consists of a plurality of electrodes capable of measuring bioelectric impedance (column 3, lines 3-10), a memory unit that stores personal data (column 3, lines 52-55), a microprocessor control unit that stores (column 6, line 65 to column 7, line 5) and recovers personal data from the memory (column 6, lines 31-48), and a display unit (column 6, lines 49-57). The device is capable of measuring and displaying user's body weight (column 3, lines 1-2) and it is configured to turn on/begin analyzing after the user is in contact with the electrodes (figure 9, element 132 and 134). Furthermore there are scroll up, scroll down, and enter buttons disposed on the upper surface of the device body (figure 2; elements 38 and 40) and the device goes into idle mode after 30 seconds of non-activity (figure 9; elements 148 and 150). However, Drinann's body analyzer differs from the claimed invention in that user data stored into the memory is accessed by touching buttons (element 36) instead of touching the electrode sensors. Also Drinan does not disclose a touch sensitive switch circuit for switching between a fat measuring circuit and the touch sensitive switch or inversely. ==

Trautman teaches recovery of stored data via actuation of an icon on a touch screen (column 6, lines 53-61; figure 8).

Regarding claims 6, 8-10, and 12-14; it would have been obvious to one of ordinary skill in the art at the time of the invention to replace Drinann’s personal data

recovery by pressing buttons with Trautman's recovery means via actuation by touch. It would have been obvious to use the electrode sensors as the actuators for touch recovery of the personal data.

Further regarding claims 6 and 10; it would have been obvious to one of ordinary skill in the art at the time of the invention to indicate which one of the personal data profiles was actuated by touch.

In regards to claims 15 and 16; it would have been obvious to one of ordinary skill in the art at the time of the invention use a switch circuit to change between waiting for a touch input and measuring the bioelectric impedance and vice versa.

6. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drinan in view of Trautman as applied to claims 6 and 9 above, and further in view of Iwabuchi (US Patent 6,360,124).

The Drinann/Trautman combination is described above; however it does not specify that each of said electrode sensors have identification.

Iwabuchi teaches the identifying the electrodes in a bioelectric impedance measuring device (figure 1, elements A, B, C, and D).

It would have been obvious to one of ordinary skill in the art at the time of the invention to identify the electrodes of the Drinann/Trautman as taught by Iwabuchi.

7. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drinan in view of Trautman.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,456,873 by Inoue et al. which discloses a body fat meter similar to the disclosed invention.

U.S. Patent 6,472,888 by Oguma et al. which discloses a bioelectrical impedance measuring apparatus that stores personal data to a storage device.

U.S. Patent 6,256,532 by Cha which discloses an apparatus for analyzing body composition based of bioelectrical impedance.

U.S. Patent 6,088,615 by Masuo which discloses a device that measures bioelectrical impedance and body weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM J. EISEMAN whose telephone number is (571)270-3818. The examiner can normally be reached on Mon-Thurs, 8:00 PM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AE
/A. J. E./
Examiner, Art Unit 4153
3/17/2008

/Gary Jackson/
Supervisory Patent Examiner
Art Unit 4153